

REMARKS

I. Summary of the Office Action

Claims 1-32, 36-73, and 77-158 are pending in this application.

Claims 28, 69, 120, and 158 have been allowed.

The correction of the drawings have been approved.

Claims 1-4, 6, 8-18, 20-22, 30-32, 36-45, 47, 49-59, 61-63, 71-73, 77-86, 88, 90-100, 102-104, 111-119, 121-124, 126, 128-138, 140-142, and 149-157 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beachley U.S. Patent 3,762,712 (hereinafter "Beachley") in view of Brenner et al. U.S. Patent 5,830,068 (hereinafter "Brenner").

Claims 5, 7, 29, 46, 48, 70, 87, 89, 110, 125, and 148 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beachley and Brenner as applied to claims 1, 42, 83, and 121, and further in view of Walker et al. U.S. Patent No. 6,001,016 (hereinafter "Walker").

Claims 19, 23-27, 60, 64-68, 101, 105-109, 139 and 143-147 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beachley and Brenner as applied to claims 1, 42, 83, and 121, and further in view of Hirsimaki U.S. Patent No. 4,001,551 (hereinafter "Hirsimaki").

II. Summary of Applicants' Reply

Applicants have amended independent claims 1, 42, 83, and 121 to incorporate the subject matter of dependent claims 27, 68, 109, and 147. Therefore, dependent claims 27, 68, 109, and 147 have been cancelled without prejudice. The claimed subject matter of dependent claims 27, 68, 109, and 147 recite "using the interactive wagering application to automatically apply wagering pool selection criteria that are based on pool values associated with using each of the multiple wagering pools." Applicants have modified the claimed subject matter of the dependent claims to recite that "the interactive wagering application automatically applies wagering pool selection criteria that are based on pool values associated with each of the multiple wagering pools to determine which one of the multiple wagering pools the wager is to be placed" to more particularly define the invention. Applicants believe that the clarifying amendment made to the dependent claims being incorporated into independent claims 1, 42, 83, and 121 does not introduce new subject matter. Therefore, applicants believe there is no need to perform a new search.

III. Approval of the Correction the Drawings

Applicants note with appreciation that the correction to the drawings were approved.

IV. Applicant's Reply to the Rejection of Independent Claims 1, 42, 83, and 121

Independent claims 1, 42, 83, and 121 were rejected under 35 U.S.C. § 103(a) as being unpatentable, over Beachley in view of Brenner. Applicants respectfully traverse this rejection.

Independent claims 1, 42, 83, and 121 are directed to a method for using an interactive wagering application, interactive wagering systems that use an interactive wagering application, and a computer readable medium for use in an interactive wagering application. Applicants' invention, as defined by independent claims 1, 42, 83, and 121, allows a user to create a wager of a particular type (e.g., win, place or show) for a particular race (e.g., Kentucky Derby). Access is provided to multiple wagering pools that are independent of each other, with each pool being capable of accepting the wager of the particular type for the particular race. An interactive wagering application is used to place the wager with one of the multiple pools. Claims 1, 42, 83, and 121 have been amended to specify that the interactive wagering application automatically applies wagering pool selection criteria that are based on pool values

associated with each of the multiple wagering pools to determine which one of the multiple wagering pools the wager is to be placed.

The amendments to claims 1, 42, 83, and 121 are based on the subject matter of original claims 27, 68, 109, and 147. Claims 27, 68, 109, and 147 have therefore been cancelled without prejudice. Although the subject matter of claims 27, 68, 109, and 147 is incorporated into amended claims 1, 42, 83, and 121, applicants have amended the incorporated subject matter to more particularly define the invention. Even in light of the additional amendment, applicants believe that the amendments to claims 1, 42, 83, and 121 do not require a new search.

Applicants will address the patentability of amended claims 1, 42, 83, and 121 with respect to the Examiner's rejection of claims 27, 68, 109, and 147. Particularly, the Examiner rejected claims 27, 68, 109, and 147 over Beachley in view of Brenner in further view of Hirsimaki.

Generally speaking, Brenner refers to an interactive wagering system.

Beachley refers to a game for wagering on horse races. The game employs the use of a card, which is filled out by a wagerer prior to a "race," authenticated by a "keeper," and returned to the wagerer after being

authenticated. An illustration of this card is shown in FIG. 3. The race may be simulated by spinning a spinner, such as that shown in FIG. 1, to determine which horse wins a particular race. Alternatively, the race may be an actual horse race that takes place at a racetrack. Regardless of whether the race is simulated or an actual event, the wagerer places his or her wagers by filling in the appropriate ovals on the card.

The card shows ovals that can be filled in to designate a particular horse (e.g., horse 11) running in a particular race (e.g., race number 1). Other ovals are shown corresponding to Pool #1, Pool #2, Quinella, Exacta, Regular, Win, Place, Show, and various wager amounts.

Hirsimaki refers to a mechanical calculating device for calculating win, place, and show odds for pari-mutuel wagering events (see Abstract).

A. The Combination of Hirsimaki, Brenner, and Beachley does not Show or Suggest
Applicants' Claimed Features

The Examiner states that column 10, lines 56-61 of Brenner "teaches automatically applying selection criteria so that certain users are "permitted to have access to certain racetracks (and their associated totes), sets of races, wager types (i.e., wagering pools), or wager amounts" (page 11, lines 16-19). Thus, while Brenner discloses that there may be a selection of

which user terminals are granted access to certain racetracks, wager types, or wager amounts, this is the not same thing as automatically applying wagering pool selection criteria based on pool values associated with each of the multiple wagering pools to determine which pool the wager is to be placed.

In fact, when the claimed invention is considered as a whole, applicants' feature of automatically applying selection criteria based on the pool values of the multiple pools to determine which pool the wager is to be placed is a specific improvement over Brenner. The Examiner has even acknowledged the novelty over Brenner with respect to applicants' feature of automatically applying wagering pool selection criteria that are based on pools values to determine which pool the wager is placed (Office Action, page 11, lines 20-21).

Moreover, this specific improvement is not shown by the combination of Brenner, Beachley, and Hirsimaki. Beachley merely refers to a card that is filled out by a wagerer prior to a race, and hence fails to show or suggest automatically applying wagering pool selection criteria based on the pool values to determine which pool the wager is to be placed. Moreover, even if Brenner and Beachley can be combined, the combination would not show automatic application of wagering pool

criteria that is based on pool values to determine which pool the wager is to be placed.

Hirsimaki merely refers to a mechanical calculating device for calculating win, place, and show odds for wagering events. Nothing in Hirsimaki shows or suggests using a calculating device to automatically apply wagering pool selection criteria based on pool values to determine which pool the wager is to be placed. Even if Hirsimaki could be combined with Brenner and Beachley, the combination of Hirsimaki, Brenner, and Beachley would only be able to show the pool values for each wagering pool. The combination of Hirsimaki, Brenner, and Beachley would not be able to place a wager in a pool according to automatically applied wagering selection criteria based on pool values of the multiple wagering pools.

Accordingly, for at least the foregoing reason that Beachley, Brenner, and Hirsimaki, whether taken alone or in combination does not show or suggest using an interactive wagering application to automatically apply wagering pool selection criteria that are based on pool values associated with each of the multiple wagering pools to determine which one of the multiple wagering pools the wager is to be placed, claims 1, 42, 83, and 121 are allowable.

B. Applicants' Reply Concerning the
Motivation to Combine the References

Applicants respectfully submit that the Examiner has not pointed to an objective teaching in Hirsimaki, Brenner, nor Beachley nor to knowledge generally available to one of ordinary skill in the art, that would lead that individual to modify the combination of Brenner and Beachley to incorporate a mechanical odds calculator. Instead of providing an objective teaching of a motivation to utilize the calculator of Hirsimaki with the interactive wagering application of Brenner, the Examiner concludes "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brenner in view of Hirsimaki to automatically select the wagering pool that has the highest pool value for a particular wager in order to maximize the payout to the player" (Office Action, page 12, lines 1-4). This does not point to any objective teaching that would lead one of ordinary skill in the art to modify the combination of Brenner and Beachley, especially in light of the fact that the combination of Brenner and Beachley does not show automatically applying wagering pool selection criteria to select which pool the wager is to be placed (as discussed above under subheading A).

Simply pointing to a teaching that discloses that odds for win, place, and show can be calculated for a pari-mutuel wagering event is not in and of itself

motivation. Here, the Examiner contends that because the calculator can be used to determine which pools provide the best value, it would be obvious to modify the combination of Brenner and Beachley in light of Hirsimaki. This is not proper motivation because it is premised without regard to the fact that the combination of Brenner and Beachley do not teach automatically applying wagering pool selection criteria based on pool values to select a pool for placing the wager (as discussed above under subheading A).

Applicants respectfully submit that the Examiner has employed hindsight reconstruction in modifying the combination of Brenner and Beachley in light of Hirsimaki. With the knowledge of applicants' novel approach of automatically applying wagering pool selection criteria based on pool values to determine which pool the wager is to be placed, particular features of the prior art were identified for use in rejecting applicants' invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine at 1600 ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

For at least the reason that the Examiner failed to point to a suggestion or motivation for

modifying the combination of Brenner and Beachley in view of the teachings of Hirsimaki and that impermissible hindsight was used to combine the references, claims 1, 42, 83, and 121 are allowable.

V. Applicants' Reply to the Rejection
of the Dependent Claims

Claims 2-26, 29-32, 36-41, 43-67, 70-73, 77-82, 84-108, 110-119, 122-146, and 148-157 were rejected under 35 U.S.C. § 103(a) over one of the following combinations:

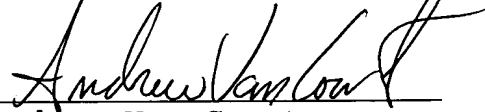
(1) Beachley in view of Brenner, (2) Beachley in view of Brenner in further view of Walker, and (3) Beachley in view of Brenner in further view of Hirsimaki.

Because applicants have demonstrated in the foregoing that independent claims 1, 42, 83, and 121 are allowable, dependent claims 2-26, 29-32, 36-41, 43-67, 70-73, 77-82, 84-108, 110-119, 122-146, and 148-157 are also allowable.

VI. Conclusion

The foregoing demonstrates that claims 1-26, 28-32, 36-67, 69-73, 77-108, 110-146, and 148-158 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew Van Court", is written over a horizontal line.

Andrew Van Court
Registration No. 48,506
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000